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P.S. 7/25/02



Docket No. 12969-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#9/B
7/24/02
1c

5 Applicant: Bitler et al

Group Art Unit: 1714

Serial No.: 09/810,920

Examiner: Peter Szekely

Filing Date: March 16, 2001

10

Title: Polymeric Thickeners for Oil-containing Compositions

Box AF

Assistant Commissioner for Patents

15 Washington, DC 20231

Sir,

REPLY

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TC 1700

20 This paper is filed in reply to the Office Action mailed May 8, 2002, which is a final rejection. Applicants note with appreciation the allowance of many of the claims. Reexamination, reconsideration and allowance of the rejected claims are respectfully requested in view of the Amendments and Remarks below.

25 **REQUEST TO RECONSIDER THE FINALITY OF THE OFFICE ACTION**
and
CONDITIONAL PETITION TO THE COMMISSIONER

30 If the Examiner does not agree that this application is now in condition for allowance, he is asked to reconsider and withdraw the finality of the Office Action. If the

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Examiner does not withdraw the finality of the Office Action, please treat this request as a Petition to the Commissioner to do so.

Applicants submit that the finality of the Office Action should be withdrawn
5 because the Office Action does not make it clear why claims 1-5, 9-12, 20, 37 and 38 have been rejected under 35 U.S.C. 102 and 103, and that as a result, no clear issue, suitable for consideration on appeal, has developed between the Examiner and the Applicants.

10 Rejected claims 1-5, 9-12, 20, 37 and 38 contain (directly or through their dependencies) a limitation that the side chain crystalline (SCC) polymer is "present in amount such that it thickens the oil". Applicants have argued (and continue to argue) that this limitation distinguishes these claims from the Mueller reference, in which an SCC polymer is added to a particular type of oil in an amount which makes the oil more
15 pourable (i.e. thinner). Nevertheless, it is clear that the rejection of these claims under 35 U.S.C. 102/103 is based on the assumption that this limitation should be ignored. Thus, paragraph 14 of the Office Action, which sets out the rationale for the rejection of these claims under 35 U.S.C. 102 and 103, does not answer the Applicants' arguments, fully set out in the previous Reply, that this limitation distinguishes these claims from
20 Mueller, but rather contains the following statements:

Since the minimum amount of side chain crystalline polymer necessary to thicken the oil is not known, the limitation is meaningless. Furthermore the limitation is new matter and not enabling.

and

25 *Since applicant is trying to cover the 1-2% range with their new limitation, the 2-10 % range limitation is meaningless.*